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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/202,838	01/21/2000	BERTRAND VERDAGUER	TSR1504.1	3464

7590 11/19/2003

THE SCRIPPS RESEARCH INSTITUTE  
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LA JOLLA, CA 92037

EXAMINER
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ZHOU, SHUBO

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/202,838	VERDAGUER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Shubo "Joe" Zhou	1631	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 August 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 and 16-24 is/are pending in the application.
- 4a) Of the above claim(s) 19,20 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9,16,17 and 19-24 is/are rejected.
- 7) ☒ Claim(s) 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to RCE and Amendment***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's amendment and submission filed on 8/22/03 has been entered.

Claims 19-20 and 22 are drawn to sequences other than the elected SEQ ID NO:3, and thus drawn to non-elected inventions. Therefore, the claims are withdrawn from consideration. Claims 1-9, and 16-24 are currently pending.

The rejection of claims 1-9 under 35 U.S.C. 112 (enablement rejection) have been withdrawn in view of the amendment and argument detailed on page 7-11 of the response.

### ***Claim Rejections-35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 23 and 24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claims 23-24 are drawn to an isolated nucleic acid sequence. However, unlike isolated nucleic acid, a nucleic acid sequence, per se, does not fall to the category of statutory subject matter: process, machine, manufacture, or composition of matter, or improvements thereof. It is merely nonfunctional descriptive material.

***Claim Rejections-35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-9, and newly added claims 16-17, 21 and 23-24 are rejected under 35 U.S.C. § 102(b) as being anticipated by Calvert et al. (IDS document: J Gen Virol. May 1995, Vol. 76, pages: 1271-8).**

This rejection is reiterated from the previous Office action and maintained for reasons of record.

Applicants' argument is essentially on the ground that the reference does not teach the claimed isolated nucleic acid molecule. This is not found persuasive. Calvert et al. clearly discloses that the genomic DNA of CVMV virus is cloned into a plasmid vector of pCKIZ and sequenced (page 1273, left column). The plasmid vector containing the viral sequence is indeed a nucleic acid molecule.

It is noted that claims 1 and 8 are amended from "at least 80%" to "at least 95%" identity to 18 consecutive nucleotides of SEQ ID NO:3. The claims are now drawn to a nucleic acid molecule comprising a nucleic sequence that is at least 95% identical to 18 sequential nucleotides of SEQ ID NO:3. As repeatedly set forth in the previous Office

action, the sequence disclosed by Calvert et al. is 98.2% overall identical to SEQ ID NO:3, which is 524 nucleotides long, and the difference is only two nucleotides at the 5' end and a few at the 3' end. Clearly, the molecule disclosed by Calvert et al., i.e. the plasmid comprising the viral sequence comprises at least a sequence that is at least 80% or 95% identical to 18 consecutive nucleotides of SEQ ID NO:3. It should be pointed out that due to the open language "comprising" and the limitation of nucleotide sequence being 95% identical to at least 18 consecutive nucleotides, not the entirety, of SEQ ID NO:3, the molecule and sequence disclosed by Calvert read on the claimed invention.

### **Claim Objections**

Claim 18 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 2, 7, and 21 are objected to because they contain subject matter drawn to unelected inventions. The sequence of SEQ ID NO:3 (pA) has been elected by applicants, but sequences other than SEQ ID NO:3 are present in the claims.

Appropriate corrections are required.

### **Conclusion**

No claim is allowed.

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not


mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703) 308-4242 or (703)305-3014.

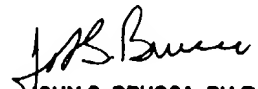
Any inquiry concerning this communication or earlier communications from the examiner should be directed to:  
Shubo "Joe" Zhou, Ph.D., whose telephone number is (703) 605-1158. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703) 308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Patent Analyst Tina Plunkett whose telephone number is 703)-305-3524, or to the Technical Center receptionist whose telephone number is (703) 308-0196.

S. "Joe" Zhou, Ph.D. 

Patent Examiner

  
JOHN S. BRUSCA, PH.D  
PRIMARY EXAMINER